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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/931,345  | 08/16/2001  | Byung Ju Dan         | 2080-3-36           | 2636             |
| 35884   | 7590        | 03/16/2006           | EXAMINER            |                  |
| LEE, HONG, DEGERMAN, KANG & SCHMADEKA, P.C.<br>801 SOUTH FIQUEROA STREET<br>14TH FLOOR<br>LOS ANGELES, CA 90017 |             |                      | SHAH, MILAP         |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3714                |                  |

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|   |                 |              |  |
|---|-----------------|--------------|--|
| <b>Advisory Action</b><br><b>Before the Filing of an Appeal Brief</b> | Application No. | Applicant(s) |  |
|   | 09/931,345      | DAN ET AL.   |  |
|   | Examiner        | Art Unit     |  |
|   | Milap Shah      | 3714         |  |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attached "Response to Amendment". (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 3-8, 14-23 and 25-28.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Attached "Response to Arguments".  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Response to Amendment**

This advisory action is in response to the amendment after final rejection filed February 17, 2006 of which the contents are not being entered for the following reason:

The amendment to the independent claims introduces a new negative limitation that requires a new search and consideration and may be new matter. The Examiner reviewed the originally filed specification and cannot locate a passage that supports the newly added negative limitation to the independent claims. No such passage was found specifically stating or supporting that the “actual toy is not a cyber character.” The Examiner respectfully requests the Applicant to point out where in the specification support for this claim limitation can be found.

### **Response to Arguments**

Applicant's arguments filed February 17, 2006 have been fully considered but they are not persuasive.

Applicant initially argues that an “actual toy” and a “virtual toy” are not equivalent. The Examiner respectfully disagrees. Applicant discusses that physical make up of the actual toy is different than the physical make up or lack of physical make up of a virtual toy, which the Examiner notes and acknowledges. However, The Office & The Examiner continues to take the position that an actual toy is equivalent to a virtual toy. An “actual toy” is considered a “toy” in the “real world”, “real life” or “physically real” having a command sent to it so it may perform actions, movements, jumps, play sounds, or anything else that can be done with a command. A “virtual toy” is considered the graphical representation of the same exact toy depicted on a computer screen or monitor, wherein having an equivalent command sent to it, makes the toy capable of performing the same actions, movements, jumps, sounds, etc. as that of the “actual toy”. The results of sending an

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equivalent command to either an “actual toy” or a “virtual toy” are considered equivalent, and therefore, the “actual toy” and “virtual toy” will be treated as equivalents since both are capable of performing the same actions and producing the same results. Hereafter, the “actual toy” and “virtual toy” are considered equivalents and may be referred to as “toy”. The Examiner’s example of the character drawing from the last office action is supported with the above explanation of how the two toys are being treated as equivalents. The character drawn on a computer screen as discussed in the last office action would be the virtual character having the same graphical representation as the real drawing of a character on a piece of paper in the real world. Both are equivalents, where one is depicted on a screen and one is on a piece of paper in the real world. Furthermore, another example in the gaming art comes from the casino/gambling industry in which The Office considers mechanical slot machines and video slot machines as equivalents. Both types of machines have physically different parts and circuitry, however both produce equivalent results. The virtual part of this example is a symbol reel in a video slot machine being equivalent to the actual physical reel of a mechanical slot machine, in which both, again, produce equivalent results.

The Applicant further argues that transfer of information via electronic mails through an electronic mail server, such as the one taught by Hachiya et al. between a “virtual toy” or cyber character and an “actual toy” is not equivalent to the same transfer between two “virtual toys” or cyber characters as in Hachiya et al. Having set up the explanation that an “actual toy” is in fact equivalent to a “virtual toy” above, the Hachiya et al. electronic mail server transfer data from toy-to-toy is considered analogous art in which virtual-toy-to-virtual-toy communication is adaptable to virtual-toy-to-actual-toy (both boiling down to “toy-to-toy” since actual is equal to virtual) communication and one of ordinary skill in the art would be motivated to combine the references in order to provide a convenient transfer means for Gabai’s toy-to-toy transfer of data, which would be processed via simple e-mail. As stated by the Applicant (pp. 10-11), Hachiya et al. disclose transfer

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of data using an electronic mail server and electronic mails between two cyber characters or virtual toys, which incorporates a teaching of a toy-to-toy transfer using electronic mails and an electronic mail server, thus, one of ordinary skill would have looked at Hachiya et al. for a teaching of toy-to-toy transfer means when looking for additional "various input devices" for use in Gabai's invention, such as the electronic mail server and adapt that concept in the toy-to-toy communication as disclosed by Gabai, where the first toy would be a virtual toy and the second toy would be an actual toy.

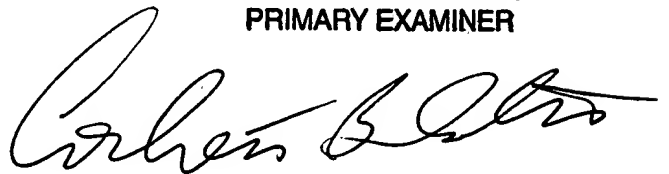
### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**CORBETT B. COBURN**  
**PRIMARY EXAMINER**



M.B.S.